

APPLICANT(S): EDLIS, Ofir et al.
SERIAL NO.: 09/780,470
FILED: February 12, 2001
ASSIGNEE: Intel Corporation
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Remarks to the Specification

The amendments to the specification are editorial in nature and are meant to correct form and language only. No new matter has been added.

The abstract has been amended in the interests of clarity.

The paragraph beginning on page 5, line 32, has been amended to correct an inadvertent typographical error. This amendment cures the objection to the disclosure stated in para. 1 of the Office Action. Accordingly, Applicants request withdrawal of the objection.

The paragraphs beginning on page 1, line 6; page 2, line 13; page 8, line 7; page 8, line 10; page 8, line 24 and page 9, line 7, have been amended to correct inadvertent typographical errors.

The paragraph beginning on page 6, line 23, has been amended for uniformity of the text of the specification and the figures.

The paragraphs beginning on page 4, line 18; page 5, line 17 and page 7, line 29, have been amended in the interests of clarity.

Remarks to the Drawings

Fig. 2 has been amended to reflect the text on page 5, lines 19 to 21, by adding the words "IN PARALLEL" at the start of the diverging paths that follow step 124, and continuing step 132 in parallel with steps 126, 128 and 130 until an affirmative answer is reached to "PILOT SIGNAL FOUND" in step 130. No new matter has been added.

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Fig. 5A has been amended in the interests of clarity, by altering step 168 to read "WAIT TIME T". No new matter has been added.

Fig. 8 has been amended to reflect the text on page 9, lines 1 to 6. In Fig. 8, the divergent paths following step 310 have been redrawn, and the words "IN PARALLEL" have been added. No new matter has been added.

Status of Claims

Claims 1-19 are pending in the application. Claims 1-19 have been rejected. Claims 1, 2, 3, 5-13 and 16-19 have been amended.

Applicants respectfully assert that the amendments to the claims, specification, drawings and abstracts add no new matter.

Claim Objections

In the Office Action, the Examiner objected to claims 1-19 because the lines are crowded too closely together. Amended claims 1-19 are hereby being filed with lines double-spaced in order to cure this objection. Accordingly, Applicants request withdrawal of the objection.

Claim Rejections

35 U.S.C. §112 Rejections

In the Office Action, the Examiner rejected claims 1, 5, 10 and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5 and 12 as amended no longer recite "substantially simultaneously".

Claim 10 as amended no longer recites "generally no reception".

Applicants respectfully assert that these amendments render claims 1, 5, 10 and 12 proper under 35 USC 112 and request that the rejections be withdrawn.

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35 U.S.C. §102 Rejections

In the Office Action, the Examiner rejected claims 1-5, 8, 9, 12 and 13 under 35 U.S.C. §102(b), as being anticipated by Kornfeld et al. (US Patent 5,758,266).

Applicants respectfully traverse this rejection in view of the remarks that follow.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (MPEP 2131)

Claim 1 as amended recites "searching for a pilot signal of a second communications system that operates according to a different communication standard than said first communication system".

Claim 12 as amended recites "a processor to interrupt reception from a first communications system, to search for a pilot signal of a second communications system that operates according to a different communication standard than said first communication system, and to resume reception from said first communication system."

With regard to claims 1 and 12, the Examiner referred to the abstract, col. 1, lines 50-63 and col. 2, lines 36-51 of Kornfeld. The abstract refers only to "code division multiple access radio", while col. 1, lines 50-63 describe CDMA systems, and col. 2, lines 36-51 describes both PCS systems and cellular CDMA systems. In each of these citations, the hand-off is from one communications system to another communication system operating at a different frequency, but both communications systems operate according to the same communication standard, i.e. cellular CDMA or PCS. Kornfeld does not teach or suggest a hand-off between communications systems that operate according to different communication standards.

Kornfeld does not teach, either explicitly or inherently, the above-quoted limitations of amended claims 1 and 12, and therefore Kornfeld cannot anticipate claims 1 and 12 as amended.

Claims 2-5, 8 and 9 are dependent, directly or indirectly, from claim 1 and include all the limitations of the independent claim; therefore Kornfeld cannot anticipate claims 2-5, 8 and 9.

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Claim 13 is dependent directly from claim 12 and includes all the limitations of the independent claim, therefore Kornfeld cannot anticipate claim 13.

In view of the preceding remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 – 5, 8, 9, 12 and 13.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 6, 11 and 14-19 under 35 U.S.C. § 103(a), as being unpatentable over Kornfeld et al. (US Patent 5,758,266) as applied to claims 1, 5 and 13 above, in view of Vilmur (US Patent 5,950,131).

In the Office Action, the Examiner rejected claim 7 under 35 U.S.C. § 103(a), as being unpatentable over Kornfeld et al. (US Patent 5,758,266) as applied to claim 5 above, in view of Rotstein et al. (US Patent 6,289,228).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (MPEP 2143.03)

Vilmur fails to cure the deficiencies of Kornfeld. In particular, Vilmur does not teach or suggest the above-quoted limitations of amended claims 1 and 12. Therefore, the Examiner's proposed modification of Kornfeld in view of the teachings of Vilmur is still missing at least one limitation of claims 1 and 12 as amended.

Rotstein fails to cure the deficiencies of Kornfeld. In particular, Rotstein does not teach or suggest the above-quoted limitations of amended claims 1 and 12. Therefore, the Examiner's proposed modification of Kornfeld in view of the teachings of Rotstein is still missing at least one limitation of claims 1 and 12 as amended.

In the Office Action, the Examiner rejected claim 10 under 35 U.S.C. § 103(a), as being unpatentable over Kornfeld et al. (US Patent 5,758,266) as applied to claim 1 above, in view of Rainish et al. (US Patent 6,606,490).

Rainish et al. qualifies as prior art only under 35 U.S.C. § 102(e), yet at the time the invention of the instant application was made, both US Patent 6,606,490 and the instant

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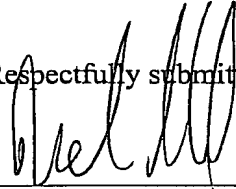
application were owned by or subject to an assignment to Intel Corporation. Therefore, under 35 U.S.C. §103(c), Rainish et al. may not be cited under 35 U.S.C. §103(a).

In view of the preceding remarks, Applicants respectfully request that the rejection of 6, 7, 10, 11 and 14-19 under 35 U.S.C. §103(a) be withdrawn.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 05-0649.

Respectfully submitted,



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Dated: May 19, 2004

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ANNOTATED SHEET SHOWING CHANGES

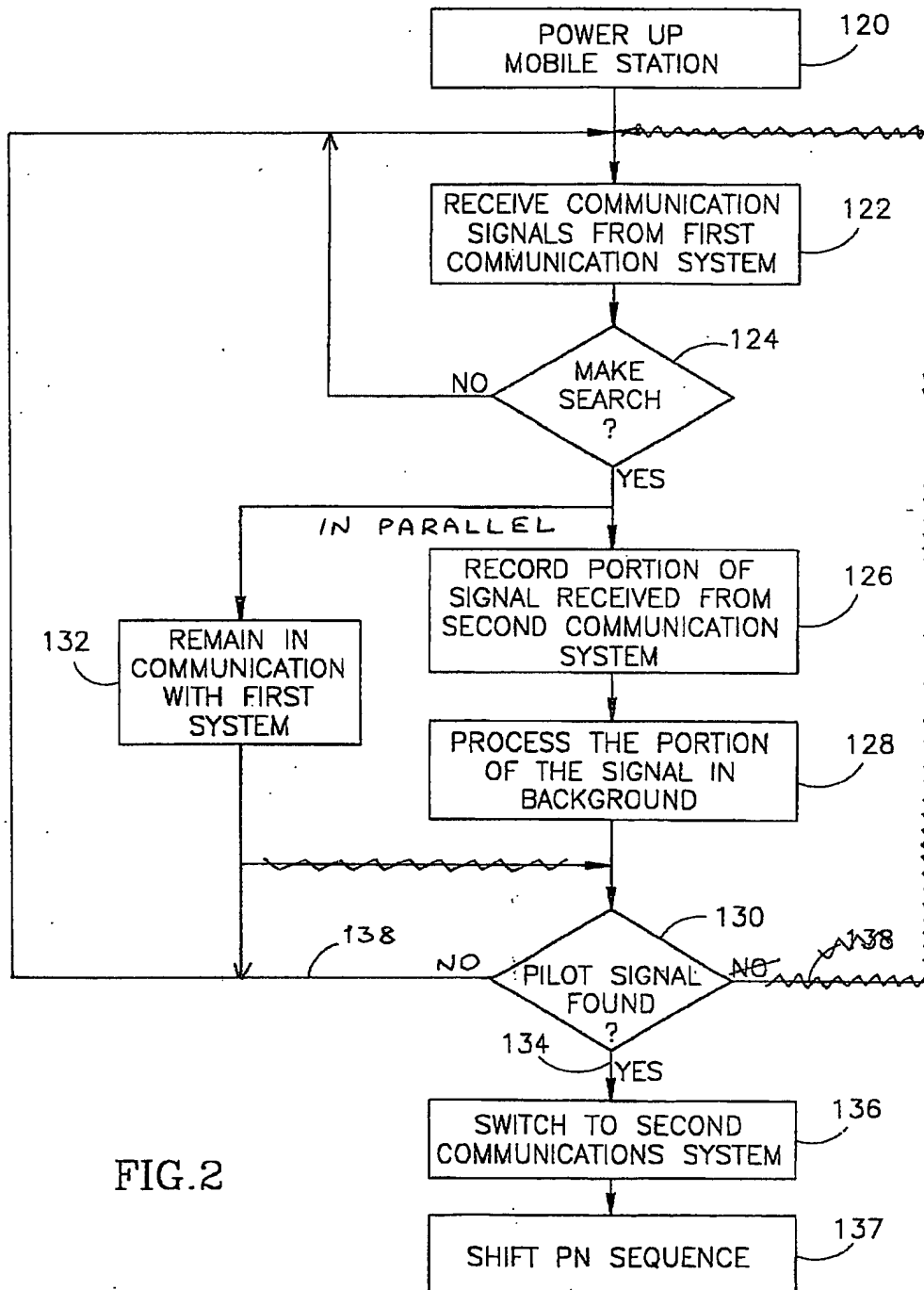
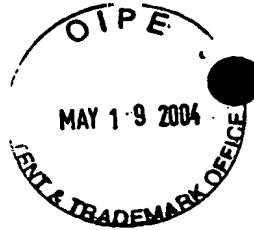
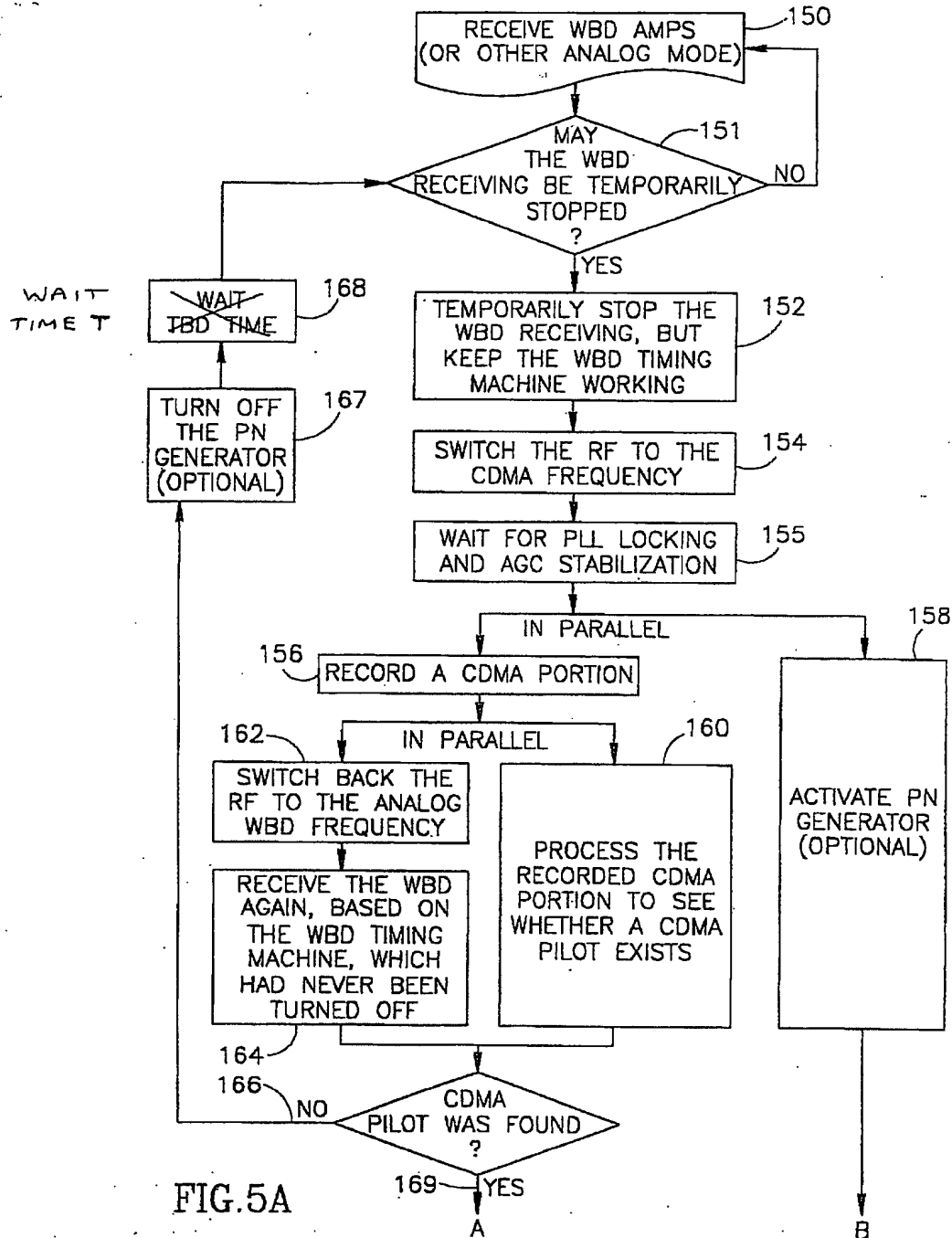


FIG. 2



ANNOTATED SHEET SHOWING CHANGES





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FIG. 7

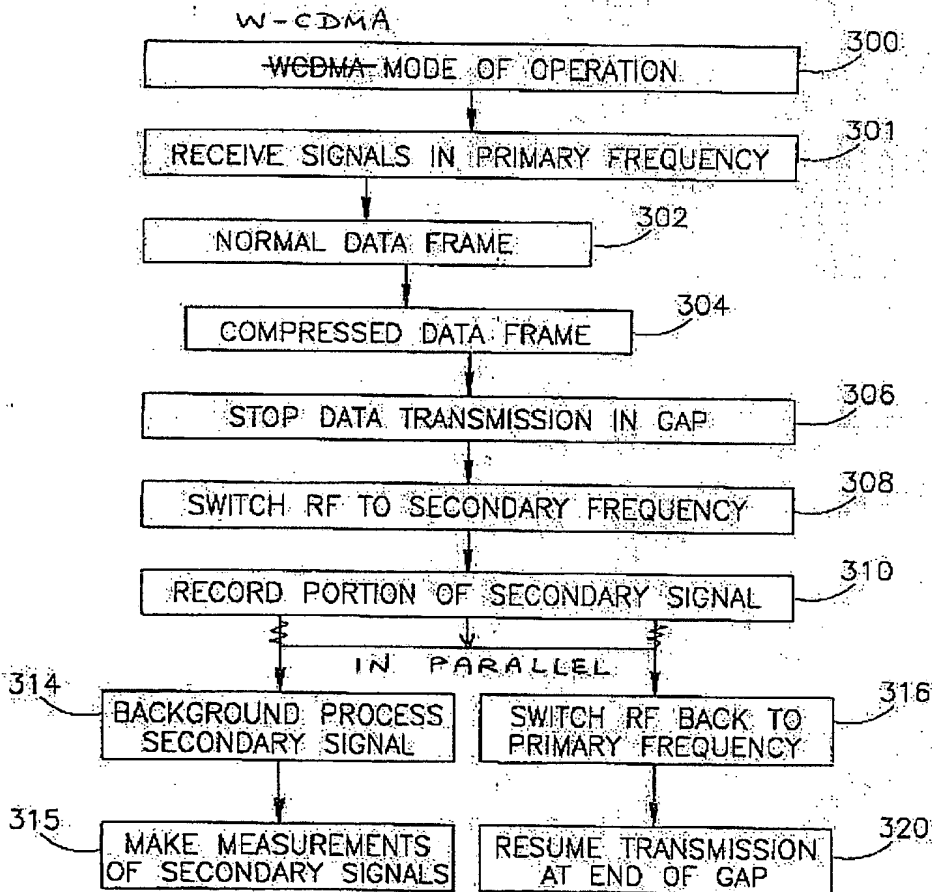
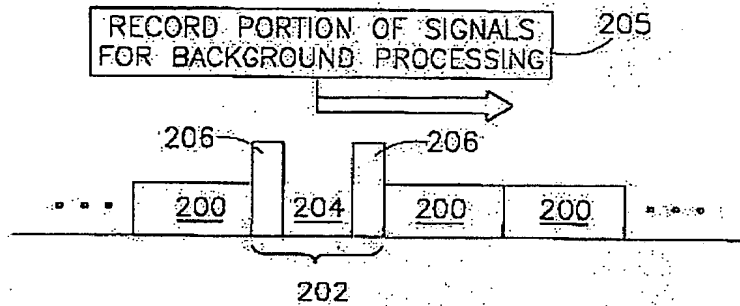


FIG. 8

APPENDIX